



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,942	03/30/2001	Sanjeev Midha	8246	8169

27752 7590 12/26/2002

THE PROCTER & GAMBLE COMPANY
INTELLECTUAL PROPERTY DIVISION
WINTON HILL TECHNICAL CENTER - BOX 161
6110 CENTER HILL AVENUE
CINCINNATI, OH 45224

EXAMINER

CHANNAVAJJALA, LAKSHMI SARADA

ART UNIT	PAPER NUMBER
----------	--------------

1615

DATE MAILED: 12/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/821,942	MIDHA ET AL.	
	Examiner	Art Unit	
	Lakshmi S Channavajjala	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 19 and 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 20-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5</u> | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1615

DETAILED ACTION

Receipt of response to election requirement, dated 11-1-02 is acknowledged.

Election/Restrictions

Applicant's election with traverse of Group I in Paper No. 9 is acknowledged. The traversal is on the ground(s) that the inventions are not "independent and distinct" and 2) there is no serious burden placed on the examiner to consider all the claims. This is not found persuasive because, while applicants argue that both sets of claims require fluid filled microspheres, polymers and an aqueous carrier, the polymers of group I are not the same as the thickening agents of group II. This is also supported by the specification, where the water-soluble or water-swallowable polymers described on pages 7-11, do not include any of the thickening agents described on pages 14-21 or vice-versa. Thus, the composition of group I can be used independent of the presence of the thickening agents of group II. Accordingly, the searching both the sets of claims places serious burden on the examiner.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1-18 and 20-22 are considered for examination. Claims 19 and 23 are withdrawn from consideration.

Claim Rejections - 35 USC § 103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 1615

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-16 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,637,291 to Bara et al (hereafter Bara).

Instant claim 1 is directed to a leave-on hair cosmetic composition comprising fluid-encapsulated, flexible microspheres exhibiting a mean particle size of less than 300 microns, a water-soluble or water-swellaable polymer, and an aqueous carrier, wherein the combination of the polymer and the microspheres result in a solid continuous or semi-continuous film network.

Bara discloses hair care and skin-care compositions, for example eye line care, tinted gel compositions etc., comprising hollow particles of an expanded copolymer of vinylidene chloride and acrylonitrile, or vinylidene chloride, methacrylate and acrylonitrile, wherein the internal cavity is filled with a gas or a hydrocarbon such as isobutene (col. 2, lines 56-67 and col. 3, lines 1-20). In particular, Bara discloses the particles sold under the name EXPANCEL 551 DE 50, 551 DE 20, 551 DE 12, etc. (col. 3, lines 26-42), all of which are also described in the instant application. Bara also discloses the particle size, density as claimed in the instant claims 3-4 and 13-14. It is implicit from the teachings of Bara, that the polymer particles possess a thermoplastic wall and thus meet the limitations of claims 5-9. Further, it is the position of the examiner that the particles of Bara meet the claim limitations of claims 10-12 because Bara uses the same polymer for the preparation of the particles and accordingly, the permeability and the property of the particles to expand upon heating is inherent.

Instant specification describes useful water soluble or water-swellaable polymers on pages 7-11, which includes natural, synthetic or semi-synthetic polymers, for example, hydroxyethyl cellulose, xanthan gum, Carbopol etc. Instant claims are not limited to a specific polymer,

Art Unit: 1615

instead only recites a water-soluble or water-swellaable polymer. Bara discloses gelling agents such as Carbopol, polyacrylates, polymethacrylate, carboxymethyl cellulose, hydroxypropylmethylcellulose, xanthan gums etc., (paragraph bridging cols 3-4 and examples in col. 7-9), which meet the claimed water-swellaable or water-soluble polymers. All the examples in columns 7-9 recite water, which meets the claim limitation, "aqueous carrier". The amounts of particles and the polymers disclosed in examples in columns 6-9 of Bara are within the claimed ranges. Bara does not explicitly state "leave-in hair cosmetic" or "leave-in hair conditioning" composition, as claimed. However, the limitations in preamble are not given patentable weight. Accordingly, the claims are interpreted as composition claims. With respect to the limitation, "wherein the combination of the polymer and the microspheres result in a solid continuous or semi-continuous film network", Bara does not explicitly state the formation of a network. However, it is the position of the examiner that the composition of Bara containing the microspheres, polymers and carrier as that claimed inherently possesses the property of forming a network. Therefore, Bara anticipates instant composition of claims 1-14.

Claim Rejections - 35 USC § 103

Claims 17 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,637,291 to Bara et al (Bara)

Instant claim 17 is directed to a leave-in hair cosmetic composition of claim 1, wherein the aqueous carrier is selected from the group consisting of hair conditioning, hair coloring or hair styling products. Claims 20-22 are directed to a method of enhancing hair volume, by applying an effective amount of the leave-in hair composition.

Art Unit: 1615

Bara teaches a cosmetic composition that reads on the composition of claims 1 and 18 (above). Bara teaches that the compositions are useful in care, cleansing and make-up of skin as well as hair, for protecting and smoothing hair, as mascara etc. Bara does not specifically give an example of such hair conditioning composition, other than an after-shave fluid. However, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to use the composition of Bara, containing hollow microparticles, gelling agents and other hair care additives because Bara teaches that microparticles impart a pleasant texture to the composition, without being greasy or causing irritating the skin, and also allows cold manufacture the hair or skin compositions thus allowing addition of heat sensitive active materials. Thus, one of an ordinary skill in the art would have expected to achieve a soft, pleasant feeling composition that is useful in hair cleansing or protecting/smoothing (which is same as conditioning) or even as a make-up (e.g., mascara).

Instant claims 20-22 recite a method of increasing the hair volume by applying the claimed composition. While Bara does not explicitly state increasing the hair volume, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention that any material (such as a mascara or hair protecting or soothing) when applied to hair would obviously result in increased volume of hair as compared to the hair volume before application.

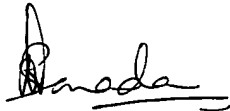
No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakshmi S Channavajjala whose telephone number is 703-308-2438. The examiner can normally be reached on 7.30 AM -4.00 PM.

Art Unit: 1615

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K Page can be reached on 703-308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7924 for regular communications and 703-308-7924 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



Lakshmi S Channavajjala

Examiner

Art Unit 1615

December 23, 2002